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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/709,977	06/10/2004	Lydia Breck	03292.101070.2	3976
66569 7590 01/22/2008 FITZPATRICK CELLA (AMEX) 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				
EXAMINER				
LOFTUS, ANNE				
ART UNIT		PAPER NUMBER		
3692				
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01/22/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/709,977

**Applicant(s)**

BRECK ET AL.

**Examiner**

ANN LOFTUS

**Art Unit**

3692

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date 8/23/07

**DETAILED ACTION**

***Status of the Claims***

1. This action is in response to an amendment filed on 10/31/07. Claims 1-8 are pending. The application is a continuation, which claims three provisionals, the earliest of which is dated 3/7/2000.

***Response to Arguments***

2. Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 5 is rejected under 35 U.S.C. 101 because the system claimed could be entirely software, as in paragraph 41 of the specification. It does not explicitly consist of functional descriptive material in combination with an appropriate computer readable medium and produce a useful, concrete and tangible result. The examiner finds a useful concrete and tangible result, but does not find a computer readable medium in this claim.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 3 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 3 and 7, the reference to a second party is unclear because no first party is identified.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 2, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5537314 filed in 1995 by Kanter in view of US Patent 5025372 filed in 1989 by Burton et al.

As to claims 1 and 5, Kanter teaches in col 20 lines 50-68 participants with multiple accounts. Kanter teaches a non-currency based account in col 21-58. It would

have been understood by a person of ordinary skill in the art at the time of the invention that a person could enroll in multiple programs, such as Kanter's invention and also Burton's invention. Kanter does not explicitly teach designating a non-currency –based account to be used to fund a primary account. Burton teaches in col 16 lines 15-55 a customer designating a program, which effectively designates an account, by filling out an enrollment form and disclosing a credit card number on the form. The customer could have designated a different account from a different program by filling out a different enrollment form, such as Kanter's. It would have been within ordinary logic and creative reasoning to a person of ordinary skill in the art at the time of the invention to modify Kanter, with predictable results and a reasonable expectation of success, to add designating a non-currency –based account to be used to fund a primary account in order to allow payment options.

The Background section of the specification of this application in paragraphs 6-12 admits that generating a secondary transaction number and associating the secondary transaction number with a primary account is old and well-known. It would have been within ordinary logic and creative reasoning to a person of ordinary skill in the art at the time of the invention to modify Kanter, with predictable results and a reasonable expectation of success, to add the known technique of generating a secondary transaction number and associating the secondary transaction number with a primary account in order to prevent interception of the primary account number.

Kanter teaches a non-currency based account in col 21-58. Kanter teaches converting accumulated non-currency based tender in the non-currency based account into currency to fund the primary account in col 4 lines 39-68.

As to claims 2 and 6, the background admits in paragraphs 8-9 that conditions-of-use parameters associated with the secondary transaction number are old and well-known. It is implicit in their use that conditions -of-use were designated at one point.

9. Claims 3, 4, 7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanter in view of Burton and further in view of Official Notice.

As to claims 3 and 7, the background admits in paragraphs 8-9 that processing an authorization request from a second party relating to a transaction involving the secondary transaction, and determining whether conditions-of-use parameters have been satisfied before continuing the transaction is old and well-known. It is implicit that a transaction includes an amount, which is by definition a transaction amount. Kanter teaches recognizing the transaction as involving a non-currency based account in col 23 lines 44-68. Kanter teaches reducing the non-currency based account balance by an amount equivalent to the transaction amount in col 15 lines 19-25. Kanter does not explicitly teach reducing, if the conditions of use parameters are satisfied, the non-currency -based account balance by an amount equivalent to the transaction amount. Official Notice is taken that if a product is purchased by redeeming an award, then the award account balance is reduced by an amount equivalent to the transaction amount. It would have been obvious to a person of ordinary skill in the art at the time of the

invention to modify Kanter with predictable results and a reasonable expectation of success, to add reducing, if the conditions of use parameters are satisfied, the non-currency –based account balance by an amount equivalent to the transaction amount in order to motivate the customer to earn more non-currency tender.

As to claims 4 and 8, Official Notice is taken that these transaction settlement steps are old and well known:

- Capturing transaction settlement information in a financial capture system
- Creating an accounts payable file and routing the accounts payable file to an accounts payable system for payment processing
- Forwarding the transaction settlement information to an accounts receivable system.

Kanter does not explicitly teach recognizing that the transaction settlement information comprises a secondary transaction number that is associated with the non-currency based account. Kanter teaches recognizing the transaction settlement information as involving a non-currency based account in col 23 lines 44-68. In paragraph 6 of the Background, the settlement processing includes substituting primary numbers for secondary numbers. It is implicit in substituting a secondary transaction number that the secondary transaction number is recognized as such. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Kanter with predictable results and a reasonable expectation of success, to add recognizing that the transaction settlement information comprises a secondary

transaction number that is associated with the non-currency based account, in order to initiate the correct processing.

Kanter teaches in col 25 lines 40-68 issuing a credit from the non-currency based account to the accounts receivable system wherein the credit from the non-currency based account offsets at least part of the transaction amount.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent 5689100 by Carrithers et al was discussed in the previous action. US Patents 5202826 by McCarthy and 6222914 by McMullin, and 6163771 by Walker are also relevant.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann Loftus whose telephone number is 571-272-7342. The examiner can normally be reached on M-F 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on 571-272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.



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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AL

/Kambiz Abdi/  
Supervisory Patent Examiner, Art Unit 3621